

~~10~~ Rec'd PCT/PTO 10 JAN 1997 #6

Attorney Docket No. ITI-169

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: KEVAN C. TAYLOR
Serial No.: 08/604,975
Filed: March 25, 1996
International Application No.: PCT/GB94/00995
International Filing Date: 9 May 1994
For: LINING OF PIPELINES OR
PASSAGEWAYS

Date: January 9, 1997

SUPPLEMENTAL SUBMISSION IN SUPPORT OF
RENEWED PETITION UNDER 37 C.F.R. § 1.47(b)
IN RESPONSE TO DECISION ON PETITION
PURSUANT TO 37 C.F.R. § 1.47(b) DATED 12 JULY 1996

Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Attention: PCT Legal Office

S I R:

RECEIVED

22 JAN 1997

**Legal Staff
International Division**

This Supplemental Submission In Support Of Renewed Petition is submitted along with the accompanying Declaration of Michael I. Wolfson in further support of the Renewed Petition filed on December 2, 1996. As noted in the Renewed Petition further multiple efforts to reach the inventor were made in December 1996. Thus, this is submitted to present a complete set of facts before the PCT Legal Office and to provide support and confirmation of three further attempts at delivery of letters addressed to Mr.

Kevan C. Taylor at his last known address in the United States, which is 501 Davis Road #H201, League City, TX 77573.

As set out in Applicant's Renewed Petition dated December 12, 1996, Michael I. Wolfson, the undersigned attorney for Petitioner, on December 11, 1996, immediately upon being advised of a more recent address for the inventor Kevan C. Taylor, prepared a new set of application papers and forwarded them to Mr. Taylor at the League City, Texas address both by Federal Express and Express Mail delivery. Prepaid return airbills and postage were provided to Mr. Taylor to facilitate his return of the documents to the undersigned. In addition, Mr. Wolfson also forwarded another set of application papers to Mr. Taylor by First Class Mail on December 17, 1996. This was done since First Class Mail will be forwarded if Mr. Taylor had moved from his last known address in League City, Texas without the need for signature.

These latest multiple diligent efforts to contact Mr. Taylor were all without success. The undersigned has been unable to obtain any response to the Federal Express, Express Mail or First Class Mail efforts to reach Mr. Taylor. There has been no communication or telephone call in response to the First Class mailing and no response from Mr. Taylor.

Filing of the application by the 37 C.F.R. § 1.47 (b) applicant is necessary to preserve the rights of Insituform and to prevent irreparable damage. The priority date of the underlying application, is 25 September 1993, within the 30 month limit allowed by the Patent Cooperation Treaty and 35 U.S.C. § 119, and

the U.S. application is therefore entitled to the priority date of the PCT application. Insituform will be irreparably harmed by the loss of this priority date and will not be able to preserve its rights to this invention under Title 35 if this Petition is denied.

Petitioner has responded fully to the Legal Examiner's Decision on Petition in December. It respectfully requests a favorable response to this Renewed Petition and that Petitioner be allowed to fully prosecute this application on the merits on behalf of and as agent for the inventor. The additional, multiple attempts to reach Mr. Taylor discussed in the Renewed Petition and herein above have all been made at his most recent last known address to no avail. Thus, the requirement of 37 C.F.R. § 1.47(b) have been diligently and completely met.

If there is any question with respect to this Petition, kindly contact the undersigned attorney by telephone so that any outstanding issue can be quickly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,



Michael I. Wolfson
Reg. No. 24,750
Attorney for Petitioner and
37 C.F.R. § 1.47(b) Applicant
COWAN, LIEBOWITZ & LATMAN, P.C.
1133 Avenue of the Americas
New York, New York 10036-6799
(212) 790-9200

#6

Attorney Docket No. ITI-169

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: KEVAN C. TAYLOR
Serial No.: 08/604,975
Filed: March 25, 1996
International Application No.: PCT/GB94/00995
International Filing Date: 9 May 1994
For: LINING OF PIPELINES OR
PASSAGEWAYS

**SUPPLEMENTAL DECLARATION OF MICHAEL I. WOLFSON
IN SUPPORT OF RENEWED PETITION UNDER 37 C.F.R. § 1.47(b)**

Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Attention: PCT Legal Office

S I R:

MICHAEL I. WOLFSON, hereby declares as follows:

1. I am a partner at Cowan, Liebowitz & Latman, P.C., attorneys for Insituform Technologies, Inc., 1770 Kirby Parkway, Suite 300, Memphis, Tennessee 38138 ("ITI"). ITI is the ultimate corporate parent of all Insituform companies, including Insituform (Netherlands) B.V., the 37 C.F.R. § 1.47(b) applicant herein. I make this Supplemental Declaration in support of the Renewed Petition to accept this application pursuant to 37 C.F.R. § 1.47(b) and describe the efforts which I took upon learning of a new address for Kevan C. Taylor, the inventor who cannot be reached and the results of such efforts.

2. On December 11, 1996, as I was completing the Renewed Petition, I learned of a new address for Kevan C. Taylor and

prepared additional new application papers including a Declaration and Assignment for Mr. Taylor's signature. As described in my December 12, 1996 Declaration, these papers were forwarded to Mr. Taylor by Federal Express and Express Mail. I also included a pre-paid Federal Express airbill and a completed Express Mail airbill with postage to facilitate Mr. Taylor's return of the signed documents to me. Copies of the letters I forwarded to Mr. Taylor by Federal Express and Express Mail on December 11, 1996 together with the enclosures, the return Federal Express airbill and envelope showing the completed Express Mail airbill and postage are annexed to my Declaration of December 12, 1996 as Exhibit A.

3. On December 17, 1996, I mailed a further letter to Mr. Taylor by first class mail. I included a copy of my December 11, 1996 letter with a new set of application papers for his signature. A copy of my December 17, 1996 letter and enclosures is annexed as Exhibit 1.

4. On December 18, 1996, I requested through my secretary Ms. Angie Carle, and received via telefax directed to her on that date, a copy of which is attached as Exhibit 2, a confirmation of delivery of Federal Express Package #8494755835, which was sent to Mr. Taylor on December 11, 1996.

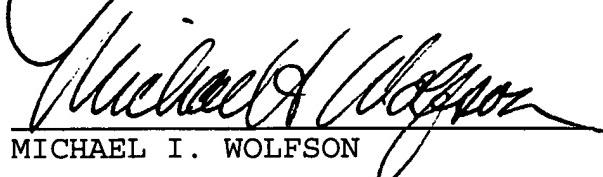
5. On December 30, 1996, the December 11, 1996 Express Mail package was returned to me. The United States Postal Service's notations on the December 11, 1996 letter indicate that delivery to Mr. Taylor at the League City, Texas address was attempted on December 13, 15 and 20th, 1996 and that the Postal Service was

unable to deliver the Express Mail package to Mr. Taylor. A copy of the label bearing the Postal Office delivery notations is attached as Exhibit 3.

6. To date, I have received no communication or response whatever from Mr. Taylor in relation to this matter, despite these three attempts to communicate with him at his last known address.

7. I have again reviewed the multiple efforts made by both my office and Mr. Donlan in the U.K. to reach Mr. Taylor at each of his three last known addresses and again respectfully submit that these efforts more than satisfy the diligent efforts requirement of 37 C.F.R. §1.47(b). In view of the extensive efforts made by petitioner, it is respectfully submitted that this Petition under 37 C.F.R. §.147(b) should be accepted.

8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



MICHAEL I. WOLFSON

Date: New York, New York
January 9, 1997

Exhibit 1

Cowan, Liebowitz & Latman, P.C.
LAW OFFICES

1133 Avenue of the Americas • New York, NY 10036-6799

Telephone (212) 790-9200 • Internet law@cll.com • Fax (212) 790-9300

Michael I. Wolfson
Direct (212) 790-9201
miw@cll.com

December 17, 1996

VIA FIRST CLASS MAIL

Mr. Kevin C. Taylor
501 Davis Road #H201
League City, TX 77573

Re: U.S. Application Serial No. 08/604,975
Based on International Patent Application
No. PCT/GB94/00955
LINING OF PIPELINES AND PASSAGEWAYS (Short-Tee Repair)
Insituform (Netherlands) BV
Our Ref. ITI-169 (20107.69)

Dear Mr. Taylor:

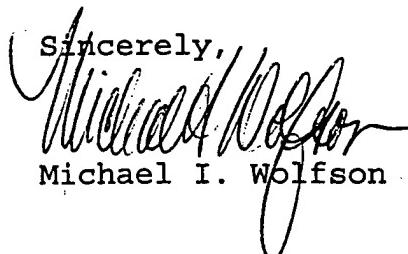
Enclosed is a copy of our letter forwarded to you by Federal Express and Express Mail on December 11, 1996.

We understand from Federal Express that the envelope was delivered to a V. Verinder at Apt. H101 who signed on your behalf on December 13, 1996. Two attempts to deliver the Express Mail envelope have been made and it is presently being held for processing.

We enclose an additional set of the document papers and appreciate you returning to us the document papers in the enclosed postage paid envelope.

Thank you for your cooperation.

Sincerely,


Michael I. Wolfson

Enclosures

cc: Insituform Technologies, Inc.
Memphis, Tennessee

Cowan, Liebowitz & Latman, P.C.
LAW OFFICES

COPY

1133 Avenue of the Americas • New York, NY 10036-6799

Telephone (212) 790-9200 • Internet law@cll.com • Fax (212) 790-9300

Michael I. Wolfson
Direct (212) 790-9201
miw@cll.com

December 11, 1996

FEDERAL EXPRESS and EXPRESS MAIL

Mr. Kevin C. Taylor
501 Davis Road #H201
League City, TX 77573

Re: U.S. Application Serial No. 08/604,975
Based on International Patent Application
No. PCT/GB94/00955
LINING OF PIPELINES AND PASSAGEWAYS (Short-Tee Repair)
Insituform (Netherlands) BV
Our Ref. ITI-169 (20107.69)

Dear Mr. Taylor:

We have been unsuccessful in reaching you after several attempts in order to have you sign the United States Declaration and Assignment in connection with this United States Application. This application is the United States national phase application based on your British and PCT applications filed in the United Kingdom relating to your Short-Tee Repair development.

In view of our inability to reach you after several attempts to your Knight Lane address in Memphis and your last known in the United Kingdom, we filed the application under Rule 47(b). This Rule permits the owner of an application to file the application without the inventor's signature if it has been unable to reach the inventor after diligent effort. We believe we have made this diligent effort. However, today we learned that you have utilized this League City address in a mortgage application and a verification of employment was sent to Insituform Technologies in Memphis in October of this year.

Our earlier efforts to reach you included letters to your Knight Lane address on February 9, 1996, August 23, 1996 and again on October 4, 1996. As noted, several attempts were also made by Andrew Donlon to contact you at Neweys Hill, Worcester. All these efforts to reach you have been unavailing.

Cowan, Liebowitz & Latman, P.C.

December 11, 1996

Page 2

In view of our obligation to make a diligent effort to obtain your signature, we enclose a new Declaration and Assignment for your signature. Please insert your address and sign and date the Declaration at page 2. Please sign the Assignment and have it notarized. Only the Assignment need be notarized.

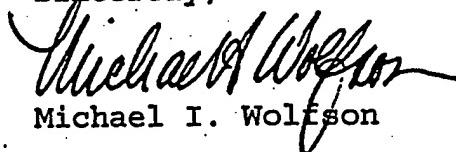
We have enclosed prepaid Federal Express and Express Mail air bills to facilitate your returning the signed documents to us.

If you have any questions concerning any of these documents or the procedures we have followed in connection with this application, please feel free to contact us by collect call.

Please give this matter your prompt attention so that we can promptly advise the United States Patent and Trademark Office whether you have signed the application declaration or whether the Patent Office must make a decision to proceed pursuant to Rule 47(b).

Thank you for your cooperation with this matter.

Sincerely,



Michael I. Wolfson

cc: Insituform Technologies, Inc.
Memphis, Tennessee

ASSIGNMENT OF UNITED STATES PATENT APPLICATION

WHEREAS, KEVAN CHARLES TAYLOR, a citizen of Great Britain and last residing at _____, is the inventor of the improvements and invention described in the PCT Application No. PCT/GB94/00995 filed 4 May 1994 and British application filed in the British Patent Office as application number 9319832.3 on 25 September 1993 for LINING OF PIPELINES AND PASSAGEWAYS, and filed in the U.S. Patent and Trademark Office concurrently herewith.

WHEREAS, Insituform (Netherlands) B.V., a corporation organized under the laws of The Netherlands and Delaware, having its principal office at West Blaak 6, 3rd Floor, 3012KK, Rotterdam, The Netherlands, hereinafter referred to as ASSIGNEE, is desirous of acquiring the entire right, title and interest in, to and under the improvements and invention described in PCT Application No. PCT/GB94/00995 and the United States National Phase application Serial No. 08/604,975 from ASSIGNOR.

NOW, THEREFORE, in consideration of the sum of Ten Dollars (\$10.00) and other good and valuable consideration paid by ASSIGNEE to ASSIGNOR, the sufficiency and receipt of which is hereby acknowledged, ASSIGNOR hereby transfers and assigns to ASSIGNEE the entire right, title and interest in, to and under the improvements and invention described in the United States National Phase application based on PCT/GB94/00995 filed in the U.S. Patent and Trademark Office and all continuations, divisionals, substitutes, renewals and reissues thereof; and

ASSIGNOR covenants that he has full rights to convey the entire interest herein assigned, and has not executed, and will not execute, any agreement in conflict herewith; and

ASSIGNOR further authorize the Commissioner of Patents and Trademarks of the United States, to record ownership in the U.S. national phase application based on U.S. PCT Application No. PCT/GB94/00995 as the property of ASSIGNEE; and

ASSIGNOR further covenants and agrees that he will communicate to the ASSIGNEE, its successors, legal representatives and assigns, any facts known to it respecting the improvements, and testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing and reissue applications, make all rightful oaths and generally do everything possible to aid the ASSIGNEE, its successors, legal representatives and assigns, to obtain and enforce proper patent protection for the improvements.

IN WITNESS WHEREOF, ASSIGNOR has subscribed hereto, this ____ day of December, 1996.

KEVAN CHARLES TAYLOR

On this ____ day of December 1996 before me came KEVAN CHARLES TAYLOR to me known and known to me to be the individual described in, and who executed the foregoing instrument, and he has acknowledged to me that he has executed the same.

Notary Public

DECLARATION, POWER OF ATTORNEY AND PETITION

As an officer of the owner of the invention and Agent of the below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe that the below named inventor is the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**IMPROVEMENTS RELATING TO THE LINING
OF PIPELINES OR PASSAGEWAYS**

the specification of which is attached hereto and was filed on 9 May 1994 as PCT/GB94/00995 and is based on an application filed in the British Patent Office as British Application No. 9319832.3 on 25 September 1993 and filed in the United States Patent and Trademark Office as Serial No. 08/604,975 on March 25, 1996.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed.

Prior Foreign Applications				
(Number)	(Country)	Day/Month/Year	Yes	No
9319832.3	Great Britain	25 Sept 1993	X	
PCT/GB94/00995	Great Britain	9 May 1994	X	

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, Section 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the application.

(App Ser No) (Filing Date) (Status)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that

these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

And I hereby appoint Michael I. Wolfson, Reg. No. 24,750, William H. Dippert, Reg. No. 26,723, R. Lewis Gable, Reg. No. 22,479, Morey B. Wildes, Reg. No. 36,968 and Regan L. Trumper, Reg. No. 38,345, correspondence address:

MICHAEL I. WOLFSON
Cowan, Liebowitz & Latman, P.C.
1133 Avenue of the Americas
New York, New York 10036

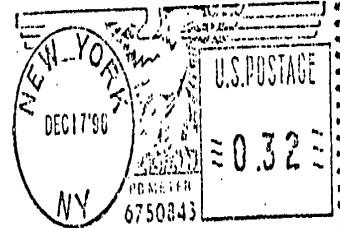
Telephone: (212) 790-9200

my attorney with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith.

Wherefore I pray that Letters Patent be granted for the invention or discovery described and claimed in the foregoing specification and claims, and I hereby subscribe my name to the foregoing specification and claims, declaration, power of attorney, and this petition.

FULL NAME OF INVENTOR KEVAN CHARLES TAYLOR	CITIZENSHIP Great Britain
RESIDENCE	
POST OFFICE ADDRESS	
AGENT'S SIGNATURE	DATE

Cowan, Liebowitz & Latman, P.C.
1133 Avenue of the Americas
New York, NY 10036-6799



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New York, NY 10036-6799
Michael I. Wolfson, Esq.

Federal Express Corporation
Customer Support
Danesco Trade
9875 Avondale Boulevard
Module H, 4th Floor
Memphis, TN 38116

U.S. Mail: P.O. Box 727
Memphis, TN 38194-4843

Telephone 901-389-6800



December 18, 1996

ANGIE CARR
(212) 790-9300

This is in response to your request for proof of delivery for package tracking number 8494755835. You will find the delivery information below.

SHIPMENT INFORMATION:

Tracking No: 8494755835

Ship Date: December 11, 1996

Shipper: DALILAH GLENN
COWAN LIEBOWITZ LATMAN
1133 AVENUE OF AMERICAS
NEW YORK, NY 10036
US

Recipient: TAYLOR, KEVIN C
501 DAVIS H201
LEAGUE CITY, TX 77573
US

DELIVERY INFORMATION:

Signed For By: V. VERINDER

Delivered to: H101

Delivery Date: December 12, 1996

Delivery Time: 03:46 PM

Your business is greatly appreciated and we look forward to the opportunity of serving your future express shipping needs.

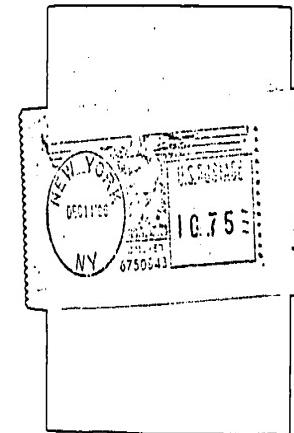
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Business	<input type="checkbox"/> Day	<input type="checkbox"/> Next Day	<input type="checkbox"/> 3PM	Postage \$ 10.15
Personal	<input type="checkbox"/> Day	<input type="checkbox"/> Next Day	<input type="checkbox"/> 3PM	Postage \$ 10.15
Customer Name and address check may be required See Post 271 and International Mail Manual	Weight	Country	Return Receipt	
	lb	INTL Area Country Code	COD	Total Postage & Fees
No Delivery	<input type="checkbox"/> Weekend	<input type="checkbox"/> Holiday	Acceptance Clark Initials	\$ 10.15

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WAIVER OF SIGNATURE (Domestic Only) I wish delivery to be made without obtaining the signature of the addressee or the addressee's agent or in the absence of the delivery addressee the article can be left in a secure location and I authorize the delivery employee to sign for the shipment and declare that the article is in good condition and will constitute valid proof of delivery.

NO DELIVERY *10/14/91*

WEEKEND *10/14/91* HOLIDAY *10/14/91*

Customer Service *10/14/91*

FROM: *Post Office* TO: PLEASE PRINT: *Kevin C. Taylor*
COHEN LIEBOWITZ & LATMAN PC
1133 AVENUE OF THE AMERICAS
36TH FLOOR
NEW YORK NY 10036-6799
77010115

TO: PLEASE PRINT: *Kevin C. Taylor*
501 Davis Street, #H201
League City, TX 77573

Customer Service *10/14/91*

PS 1991

WHEN RETURN RECEIPT SERVICE IS PURCHASED